

REMARKS

The Final Office Action of April 16, 2007 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Final Office Action.

I. STATUS OF THE CLAIMS

Claims 1-20 are pending in the application.

Claims 17 and 18 have been objected as unclear. Claims 17 and 18 have been cancelled without prejudice.

Claims 1, 3, 5, 7, 9-11, and 13-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Larsen, United States Patent # 7,134,088, issued on November 7, 2006, published on March 27, 2003, filed on July 3, 2002 (Larsen). Applicant respectfully points out that Larsen was published within one year of Applicant's filing date, July 14, 2003. Applicant reserves the right to swear behind Larsen.

Claims 2, 6, and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Larsen in view of Neiman, United States Patent # 6,604,126, issued on August 5, 2003, filed on June 29, 2001, published on January 2, 2003 (Neiman). Applicant respectfully points out that Neiman was published within one year of Applicant's filing date, July 14, 2003. Applicant reserves the right to swear behind Neiman.

Claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Larsen in view of Pyle, United States Patent # 4,446,454, issued on May 1, 1984.

II. OBJECTIONS TO THE CLAIMS

On page 2, the Office Action states that claims 17 and 18 are objected to because the Final Office Action states that the claims are unclear.

Claims 17 and 18 have been cancelled without prejudice.

III. REJECTIONS UNDER 35 U.S.C. § 102

On pages 2-5, the Final Office Action states that claims 1, 3, 5, 7, 9-11, and 13-20 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Larsen.

Applicant respectfully points out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims.

With respect to amended independent claims 1, 7, and 14, it is submitted that Larsen does not disclose or suggest Applicant's claimed steps of receiving updates to existing information and interrelating or linking updated information based on updated relationships because Larsen is limited to adding data to the system. Larsen states "creating, formatting, layering and linking images and maps" (Larsen, Appendix A, col. 12, lines 5-6), but nowhere states Applicant's claimed receiving updates to existing information and interrelating the updates. In Larsen's system, information is gathered and stored, but there is no provision to receive updates to that information, and no provision to interrelate the updated information.

On page 7, the Final Office Action states that Larsen allows the user to link HTML pages and allows the user to review information to identify modifications or corrections. It is submitted that neither the capability of Larsen to allow users to link pages, nor the capability of Larsen to allow users to review anticipates Applicant's claimed receiving updates and interrelating the updates. Larsen's capability to link to HTML pages does not include Applicant's claimed step of interrelating

the received updates because Larsen's links, if they can be considered updates, would be assumed to be independent of one another without further description of an interrelationship capability. Further, Larsen's capability of reviewing characteristic and relationship information does not imply Applicant's claimed interrelating updates because Larsen is missing the step of interrelating.

Since Larsen does not teach each and every element of Applicant's amended independent claim 1, 7, and 14, and dependent claims 3, 5, 9-11, 13, and 15-20, which depend therefrom, Applicant's amended independent claims 1, 7, and 14, and dependent claims 3, 5, 9-11, 13, and 15-20 are not anticipated by Larsen, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Further, it is submitted that amended independent claims 1, 7, and 14, and dependent claims 3, 5, 9-11, 13, and 15-20 are not made obvious by Larsen under 35 U.S.C. § 103. Applicant asserts that amended independent claims 1, 7, and 14, and dependent claims 3, 5, 9-11, 13, and 15-20 are now in condition for allowance. Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 102(e) with regards to amended independent claims 1, 7, and 14, and dependent claims 3, 5, 9-11, 13, and 15-20 for the reasons set forth above.

IV. REJECTIONS UNDER 35 U.S.C. § 103

On pages 5-6, the Final Office Action states that claims 2, 6, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Larsen in view of Neiman.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Further, "[I]f when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); see also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose)" (as cited in *Tec-Air Inc. v. Denso Manufacturing*, 192 F.3d 1353, 1360 (Fed. Cir.

1999)). In *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007), the Court identified “teaching away” as a strong indicator of nonobviousness.

With respect to dependent claim 6, it is submitted that Applicant’s claimed handheld device is not made obvious by Larsen and Neiman because (1) Larsen neither expressly nor impliedly suggests a handheld device, and in fact limits its CPU to a personal computer, and storage of its computer program to a storage medium such as a hard drive, and (2) the addition of Neiman to Larsen would render Larsen unsuitable for its intended purpose. With respect to (1), not only does Larsen not suggest the use of a handheld device, but by limiting his CPU to a personal computer, Larsen teaches away from the use of a handheld device, and therefore teaches away from combining Larsen with Neiman. With respect to (2), Neiman’s system requires a client/server configuration, in particular, to use the handheld device as a client. Neiman’s client/server system cannot be overlain on Larsen’s CPU with local, and possibly remote, storage of the data only. No shared processing is being done in Larsen, nor is it contemplated. Although it is not stated why Larsen has limited the configuration, it can be assumed that response time is the deciding factor. Larsen’s spherical images, especially those with the detail required for Larsen’s application, would require a very high transfer rate to provide the data to the user in a reasonable amount of time. The configuration in Neiman that includes the PDA would not meet this requirement because the PDA in Neiman is not performing any processing. Thus, the introduction of Neiman’s architecture would render Larsen unsuitable for its intended purpose of providing tactical information during crisis situations in a timely manner.

On page 8, the Final Office Action states that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is submitted that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, *and all teachings in the prior art must be considered to the extent that they are in analogous arts*. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, *considering the degree to which one reference might accurately discredit another*. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). [Emphasis added] It is submitted that Larsen’s lack of a description of use of a handheld

device discredits the addition of a handheld device such as Neiman discloses because a handheld device would not be adequate or suitable to receive and process the images of Larsen.

Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). It is submitted that to integrate Larsen with Neiman would require substantial reconstruction and redesign of the elements of Larsen because the handheld device of Neiman is not disclosed to perform processing of the data of Larsen.

Still further, the statement, on pages 7-8 of the Office Action, that modifications of the prior art to meet the claimed invention would have been "would have been obvious to one of ordinary skill of the art" at the time the claimed invention was made, if the references relied upon teach that all aspects of the claimed invention were individually known in the art, is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). It is submitted that nothing in Larsen suggested the use of a handheld device, and in fact Larsen's system could not operate on or in conjunction with a handheld device because of the limited processing and storage capability of a handheld device.

Finally, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.). Likewise, if Larsen and Neiman were combined, the primary purpose of Larsen, to provide tactical information during crisis situations in a timely manner, would be thwarted because the handheld device in Neiman is not configured to perform any processing whatsoever.

It is submitted that dependent claims 2 and 8 are patentable at least by virtue of their selected dependence upon amended independent claims 1 and 7.

On pages 6-7, the Office Action states that claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Larsen in view of Pyle.

On pages 8-9, the Office Action responds to the arguments with respect to dependent claim 4 that were presented in the previous Office Action. Following is a rebuttal to the response on pages 8-9 of the Office Action.

It is submitted that Larsen and Pyle, either separately or in combination, do not disclose or suggest Applicant's claimed electronic contact information automatically determined from the linked characteristic information because (1) Larsen's list of contacts and phone numbers is not automatically determined from linked characteristic information, and Larsen does not disclose or suggest an automatic contact number, and (2) Pyle cannot make up these deficiencies because Pyle's

automatic contact number is not determined from linked characteristic information. With respect to (1), Larsen's list of contacts is a table of names and phone numbers, with no links involved whatsoever, as the term "links" is commonly used in the computer arts. Further, Larsen does not disclose or suggest any automatic contacts whatsoever. With respect to (2), Pyle's automatic contact number is not determined from link characteristic information, but instead is a fixed number, dialed no matter what any linked characteristic information might provide.

There is no response provided with respect to dependent claim 12. Following, Applicant provides a repeat of the response stated in the previous Office action response with respect to dependent claim 12.

With respect to amended dependent claim 12, it is submitted that neither Larsen nor Pyle make obvious Applicant's claimed dispatcher that provides instructions to the responding contacts because (1) neither Larsen nor Pyle discloses or suggests providing instructions to the responding contacts, and (2) as stated previously, the addition of Pyle to Larsen would render Larsen unsuitable for its intended purpose. With respect to (1), neither Larsen nor Pyle receive any indication that any of the people on the contact list respond at all, and therefore, neither provides instructions to the responding contacts. Larsen simply lists possible contacts, and Pyle contacts a particular number when it receives a signal through the building's wiring system. Neither discloses or suggests the concept of responding contacts because communication, when it is disclosed, is one-way in their systems.

Since none of Larsen, Neiman, or Pyle, either individually or in combination, teaches or suggests each and every element of Applicant's dependent claims 2, 4, 6, 8, and 12, Applicant's dependent claims 2, 4, 6, 8, and 12 are not made obvious by Larsen, Neiman, and Pyle, and a rejection under 35 U.S.C. § 103(a) is inappropriate, and further the utilization of the combination of these references clearly renders Larsen inoperable. Applicant asserts that dependent claims 2, 4, 6, 8, and 12, are now in condition for allowance. Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claims 2, 4, 6, 8, and 12 for the reasons set forth above.

V. CONCLUSION


Independent claims 1, 7, and 14 are believed to be in condition for allowance for the reasons provided herein. It is submitted that dependent claims 2-6, 8-13, and 15-20, are also allowable for the reasons presented above, and further because they selectively depend upon independent claims which are believed to be in condition for allowance, and are therefore also believed to be in condition for allowance.

Although no new fees are anticipated, the Commissioner for Patents is authorized to charge any other fees, or credit overpayment to Deposit Account No. 03-2410, Order No. 32157.00101.

The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,
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